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10/069,301	02/18/2002	John Eric Arnold	DN1999215USA	2013

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THE GOODYEAR TIRE & RUBBER COMPANY
INTELLECTUAL PROPERTY DEPARTMENT 823
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EXAMINER

TORRES, MELANIE

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/069,301
Filing Date: February 18, 2002
Appellant(s): ARNOLD, JOHN ERIC

Nancy T. Krawczyk
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 15, 2006 appealing from the Office action mailed April 19, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 4,798,369	GENO ET AL.	1-1989
US 1,828,682	ROBINSON	10-1931

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geno et al. in view of Robinson.

Re claims 1, Geno et al. teaches an airspring comprising a flexible cylindrical sleeve having a first and second end, a retainer secured to one of the ends of the sleeve. However, Geno et al. does not teach a tag made from a sheet material, the improvement comprising a portion of the tag being non-removably secured between a sleeve and a retainer. Robinson teaches a tag (2) made from a sheet material, the improvement comprising a portion of the tag being non-removably secured between a sleeve (1) and a retainer (5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have had the tag of Robinson on the air spring of Geno et al. to provide identification for the manufactured part.

Art Unit: 3683

Re claim 2, Geno et al. as modified does not teach wherein the tag is of a flexible plastic or elastomeric material. The examiner takes official notice that tags are known in the art to be made of flexible plastic for their resilience.

Re claims 3 and 9, Geno et al. as modified teaches wherein a portion of the tag that is secured between the sleeve and the retainer, prior to being secured between the sleeve and the retainer, has a shaped configuration corresponding to the shaped configuration of the sleeve end.

Re claims 4 and 10, Geno et al. as modified teaches wherein the tag, prior to being secured between the sleeve and the retainer, has a molded circumferential curvature corresponding to the outer curvature of the cylindrical sleeve.

Re claim 5, Geno et al. as modified teaches wherein the tag is provided with indicia in a manner which will last the lifetime of the airspring.

Re claim 6, Geno et al. as modified teaches wherein the indicia is presented in an alphanumeric manner or as a bar code.

Re claim 7, Geno et al. as modified teaches wherein the indicia is formed by imprinting the indicia on the tag.

Art Unit: 3683

3. Claims 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Geno et al. in view of Robinson and further in view of Brewster.

Re claim 8, Geno et al. as modified does not teach wherein the color of the tag contrasts with the color of the airsleeve. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the color of the tag contrast with the color of the airsleeve because elastomeric airsleeves are well known as being inherently black. Further, Brewster teaches wherein identification tags can be color coded in order to provide a distinctive appearance. (Column 6, lines 18-20) Therefore, it is the examiner's position that making a tag and an airsleeve of contrasting colors is well known in the art.

(10) Response to Argument

Applicant provides two arguments in the Appeal brief.

1) First, Applicant argues that there is no motivation to modify or combine the prior art in the rejection under 35 USC 103 above.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Art Unit: 3683

It has also been held that motivation to combine prior art can come from the teachings of the prior art, the knowledge of persons of ordinary skill in the art and/or the nature of the problem to be solved (*In re Rouffet*, 149 F.3d 1350, 47 USPQ 2d 1453 (Fed. Cir. 1998)).

In this case, the examiner feels that providing part identification on any mechanical part is a known concept in the art for identifying parts and any person of ordinary skill would be aware of the use of a tag to identify a part. Therefore, identifying a part with a tag is not considered a novel, patentable limitation.

2) Second, Applicant argues that to modify the air spring of Geno in the manner as taught by Robinson would potentially destroy the operability of the air spring.

As can be seen in all of the drawings of the Robinson patent, there is no air gap between the components that would destroy the operability of the spring. It is unclear why Applicant argues that the combination would "potentially destroy the operability of the air spring" if it is clearly shown as a sealed arrangement in the prior art. The tag itself is engaged by a tongue on the lid that does not interfere with the seal between the retainer (5) and the beaded edge (4) of the container (1). To suggest that there would be a leak in the seal of Robinson would be to indicate that adding the tag to the can of Robinson would cause the can to leak. No support for this argument is provided by applicant. The arrangement of Robinson provides a sealed environment, so the examiner can only assume that applicant is attacking the references individually and not considering the combination. One cannot show nonobviousness by attacking

Art Unit: 3683

references individually where the rejections are based on combinations of references.

(*In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986)).

Applicant further argues that the addition of a lip as shown in Robinson (element 4) would not be practical because the material is non-flexible. First, the beaded edge (4 of Robinson) appears to be a separate component than the can (1). It would be reasonable to consider that the air spring end (21) of Geno et al. can be attached to the beaded edge (4) of Robinson with the cover (5 of Robinson) then engaging the beaded edge (4) since typically, air spring ends (21 of Geno et al.) are rolled to attach to retainer covers (3). Alternatively, the lip (21) of a flexible sleeve (as taught by Geno et al.) clearly has a necessary measure of stiffness to allow for the attachment of the rigid cover to the air spring. Therefore, the examiner feels that it would be a reasonable combination.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MT 


Melanie Torres
Primary Examiner
3-7-06

Conferees:

Application/Control Number: 10/069,301

Page 8

Art Unit: 3683

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